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PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE HONORABLE BOARD OF PATENT APPEALS AND INTERFERENCES

In re the Application of

Masahiko NAKANO

Group Art Unit: 3661

Application No.: 10/619,034

Examiner: M. ZANELLI

Filed: July 15, 2003

Docket No.: 116604

For: NAVIGATION APPARATUS

REPLY BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The following remarks are directed to the new points of argument raised in the Examiner's Answer dated December 22, 2005.

I. Formal Matters

The Examiner's Answer alleges, on page 3, lines 1-10, that the grounds of rejection that are not under review on appeal are as follows: (1) the rejection of dependent claims 7-14 as obvious under 35 U.S.C. §103(a) over U.S. Patent Publication No. 2002/0177944 to Ihara et al. (Ihara) in view of U.S. Patent No. 5,396,431 to Shimizu et al. (Shimizu); and (2) the rejection of claims 4-6 as obvious under 35 U.S.C. §103(a) over Ihara and Shimizu, and further in view of U.S. Patent No. 6,199,014 to Walker et al. (Walker) and U.S. Patent No. 6,182,010 to Berstis. Appellant respectfully submits that the grounds of rejection for claims 4-14 are under review on appeal.

The Examiner's Answer alleges that such grounds of rejection are not under review on appeal because the grounds have not been presented for review in Appellant's Appeal Brief and because Appellant has not separately argued the patentability of dependent claims 4-14. Appellant disagrees.

37 CFR §41.37 states:

Each ground of rejection must be treated under a separate heading. For each ground of rejection applying to two or more claims, the claims may be argued separately or as a group.

[T]he failure of appellant to separately argue claims which appellant has grouped together shall constitute waiver of any argument that the Board must consider the patentability of any grouped claim separately.

Claims argued as a group should be placed under a separate subheading identifying the claims by number.

As discussed in Appellant's Brief on page 4, lines 3-10, the rejection under 35 U.S.C. §103(a) over Ihara in view of Shimizu applies to claims 1-3 and 7-14, and the rejection under 35 U.S.C. §103(a) over Ihara in view of Shimizu, and further in view of Walker and Berstis applies to claims 4-6.

As discussed in Appellant's Appeal Brief on page 8, lines 16-20, Appellant argued that "[n]one of the applied secondary prior art references overcomes the above-noted deficiencies of Ihara and Shimizu. Accordingly, the dependent claims are allowable at least for their dependence on allowable base claims." Therefore, Appellant has presented the rejections of claims 4-14 for review in Appellant's Appeal Brief. Although dependent claims 4-14 are grouped and argued together, arguing grouped claims 4-14 together only constitutes Appellant waiver of any argument that the Board must consider the patentability of claims 4-14 separately.

In view of the foregoing, Appellant respectfully submits that the Examiner's position regarding the grounds for rejection that are or are not on review is inaccurate.

II. Reply to Examiner's Assertions**1. Disclosure of specific species in a genus does not make all species in that genus obvious**

The Examiner asserts, on page 4, lines 14-20, that Ihara teaches a user selecting a point along a route and display of additional information about that point, such information including photographs and images, and implies that this renders all types of photographs and images obvious. However, disclosure of specific types of species in that genus does not make all species in a genus obvious.

Independent claims 1-3 recite "the real image includes at least one of an aerial photograph and a satellite photograph," which is not taught or suggested by Ihara. As noted by the Examiner, the only specific example given by Ihara of a main point, associated with information that may be displayed, is a photograph of a restaurant. However, it is believed that this implies a frontal view of the restaurant, as it would be seen from the street, so that the driver/navigator can easily recognize the restaurant upon arrival.

Although a frontal photograph is a species of the genus of photographs, there is no suggestion or recognition in the prior art that an aerial or satellite photograph would have been obvious in the context disclosed by Ihara. (The Examiner has not met the burden of proving that it must be obvious.) Therefore, the Examiner's apparent allegation, that the general knowledge that satellite or aerial photographs can be used in some navigation systems would, by itself, have made it obvious to use such photographs in the context of "photograph" disclosed by Ihara, is without merit.

2. Nonobviousness is asserted by a showing that the asserted combination of references do not teach or suggest the claimed invention

The Examiner's Answer asserts, on page 5, lines 3-6, that "one cannot show nonobviousness by attacking references individually where the rejections are based on

combinations of references." However, Appellant does assert nonobviousness by showing that the asserted combination of references do not teach or suggest the claimed invention.

As discussed in Appellant's Appeal Brief on page 6, line 20 - page 7, line 4, Appellant points out that neither Shimizu nor Ihara teaches or suggests displaying an aerial photograph based on position information of a user-selected point. Appellant's separate discussion of Shimizu and Ihara, in Appellant's Appeal Brief, was used to explain the teaching of each reference. Because each reference is devoid of the feature of displaying an aerial photograph based on position information of a user-selected point, such feature is still missing even if the teachings of the two references are combined.

In other words, each reference must be examined for what they teach individually. If a claimed feature is missing from each reference, the claimed feature is still missing when the teachings of the references are combined. Thus, nonobviousness is asserted by a showing that the teachings of each reference individually, in addition to a showing that the asserted combination of references, do not teach or suggest the claimed invention.

3. The asserted combination of Ihara and Shimizu is based on improper hindsight reasoning

The Examiner's Answer asserts, on page 5, lines 7-12, any judgment on obviousness that takes into account only knowledge which was within the level of ordinary skill in the art is not hindsight reasoning so long as the judgment is not gleaned from only applicant's disclosure. However, the asserted combination of Ihara and Shimizu is based on improper hindsight reasoning, as demonstrated below.

MPEP §2143.01 states the following:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.

The statement that modifications of the prior art to meet the claimed invention would have been "well within the ordinary skill of the art at

the time the claimed invention was made" because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some suggestive reason to combine the teachings of the references. (emphasis added)

The Examiner's Answer asserts, on page 5, lines 13-14, that Ihara discloses providing additional information about a point on a route, including photographs. The Examiner's Answer also asserts, on page 5, lines 14-15, that Shimizu discloses a known type of photograph/image to inform a user about a geographical area. Although the Examiner's Answer asserts, on page 15-16, that both references are directed to providing the user with information to aid in navigation, Shimizu's disclosure of an aerial or satellite photograph is used as a map upon which the current location of a vehicle is displayed. Therefore, Shimizu's disclosure of an aerial or satellite photograph is in a different context from what Appellant discloses and claims.

The Examiner's reliance on *In re McLaughlin*, 443 F.2d 1392 (CCPA 1971) is misplaced. First, in that case, the elements in question were known in the art, in the context claimed by the applicant. Second, that the "level of ordinary skill" may have been sufficient to achieve the claimed combination of features in the present application is not relevant, unless and until there is evidence of knowledge of such features in the art, and evidence of motivation to attempt the proposed combination of prior art. *In re McLaughlin* does not eliminate the requirements for such evidence, and the Examiner simply has not provided the required evidence.

Because there is no disclosure in Shimizu of an aerial or satellite photograph in the context claimed, and because there is no recognition in the prior art of any advantage to be gained by an aerial or satellite photograph in the context claimed, it is evident that the Examiner has impermissibly relied on hindsight knowledge gained from Appellant's disclosure.

4. **The feature of displaying an aerial or satellite photograph is set forth in claim 3**

The Examiner's Answer asserts, on page 5, lines 17-19, that Appellant argues features not found in claim 3. Specifically, the Examiner's Answer appears to focus on the language "(e.g., when the vehicle approaches that point)."

Claim 3 recites "a first selection unit for selecting a point on a basis of a movement state of a vehicle, wherein the real image includes at least one of an aerial photograph and a satellite photograph; and a display control unit for displaying the real image showing a surrounding of the point selected by the first selection unit on a basis of real image data corresponding to the real image." Claim 3 does not recite "(e.g., when the vehicle approaches that point)," and Appellant does not suggest that it does.

The Examiner's Answer, on page 5, lines 19-21, then suggests that Shimizu discloses the feature in question at col. 6, lines 21-40. However, this passage refers to Fig. 6A, showing a display image in which a current position of a movable body is indicated as a black triangular mark on an aerial photograph image. See Shimizu col. 6, lines 21-40. Therefore, the aerial photograph is used as a background image in which the current position of the movable body is indicated. Although a location of the black triangular mark may change based on a movement position of the vehicle, Shimizu does not teach or suggest selection of the black triangular marks, e.g., points. Therefore, Shimizu cannot reasonably be considered to teach or suggest displaying aerial or satellite photographs, i.e., real images, showing a surrounding of the selected point, as set forth in claim 3.

III. Conclusion

For at least the reasons set forth herein and in the Appeal Brief, it is respectfully submitted claims 1-14 are patentably distinct from the applied references. Accordingly, Appellant respectfully requests the Honorable Board to reverse the rejections of claims 1-14 and pass this application to issuance.

Respectfully submitted,


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JAO:HNM

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